

Attorney Docket # 4925-95

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of

Yrjö KERÄNEN et al.

Serial No.: 09/740,299

Filed: December 19, 2000

For: Network-Based Method And System For
Determining a Location of User Equipment in
CDMA Networks

Examiner: Mehrpour, Naghmeh
Group Art: 2686

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July 26, 2006

(Date of Deposit)

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Name of applicant, assignee or Registered Representative

Signature

July 26, 2006

Date of Signature

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

This is a Request for a Panel Review of Issues on Appeal in accordance with the
Office Gazette Notice dated July 12, 2005. The present request is filed concurrently with a Notice
of Appeal and is filed before an Appeal Brief. No amendments are being filed with this request.

Arguments supporting the Request for Review begin on page 2 of the present
communication.

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REMARKS/ARGUMENTS

The Office Action mailed January 26, 2006 has been reviewed and carefully considered. Claims 1-3 and 5-21 are pending in this application, with claims 1 and 14 being the only independent claims. Reconsideration of the above-identified application, as herein amended and in view of the following remarks, is respectfully requested.

Claims 1-3 and 5-21 stand rejected under 35 U.S.C. §103 as unpatentable over U.S. Patent No. 6,681,099 (Keranen) in view of U.S. Application Publication No. 2006/0003775 (Bull).

The newly cited Bull reference does not qualify as prior art because it was published on January 5, 2006 and was filed on June 10, 2005, after the invention by applicant of the subject matter of the present application. Bull was published after the present application was filed and therefore must meet the requirements of 35 U.S.C. §102(e) to qualify as prior art. This section of the law requires that the prior art be published in an application filed before the invention by applicant. To meet this requirement, the Examiner seems to be relying on the original filing date of the parent applications of Bull. However, paragraph 0062 of Bull states that Bull is a substantial extension of the parent application and further specifically states that the parent application "describes a system that monitors communications between a base transceiver station and base station controller, and forward mobile station (MS) information to a Wireless Location System for emergency call location, the advanced location-based services applications described herein utilize additional network messages as triggering events and information sources for a wide variety of location-based services".

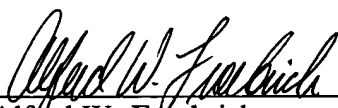
The rejection relies on information which is only presented in the Bull reference and not in the parent application, i.e., the utilization of additional network messages as triggering events (see page 4, lines 5-14, of the Office Action). Since the disclosure in Bull relied upon by

the Examiner is only published in the Bull reference and not in the parent application, the disclosure in Bull relied upon by the Examiner can only claim a filing date of June 10, 2005. Accordingly, the subject matter relied on by the Examiner was not published in an application filed before the invention by applicant and thus does not qualify as prior art under 35 U.S.C. §102(e).

Since Bull does not qualify as prior art, the application is deemed to be in condition for allowance and notice to that effect is solicited.

Respectfully submitted,

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Dated: July 26, 2006